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10/606,729	06/26/2003	Philip M. Donian	PMDP001	5831

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EXAMINER	
RETTA, YEHDEGA	

ART UNIT	PAPER NUMBER
3622	

NOTIFICATION DATE	DELIVERY MODE
10/14/2010	ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

PTO-INBOX@AKACHANLAW.COM

Office Action Summary	Application No.	Applicant(s)	
	10/606,729	DONIAN ET AL.	
	Examiner	Art Unit	
	Yehdega Retta	3622	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *02 August 2010*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *138-186* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *138-186* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

This office action is in response to amendment filed August 2, 2010. Applicant canceled claims 1-137 and added new claims 138-186. Claims 138-186 are currently pending.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 138-150, 153-168, 170-172, 175-185 are rejected under 35 U.S.C. 102(e) as being clearly anticipated by Knepper et al. (2001/0042249).

Regarding claims 138, 146, 153, 162, Knepper teaches providing a plurality of media files available for download by an electronic device; allowing a user to select a subset of the plurality of media files for download; receiving the subset of media files at the electronic device; storing the subset of media files in a memory of the device; receiving a plurality of ad files at the electronic device for storage in the memory of the device (see [0009]-[0014]); at the device, permitting a user to select a first ordering of the media files stored in the memory for playing by a media player program; for the first ordering, based on ad positioning rules, using a processor of the device, automatically generating a first sequencing of ad files to be played during playing of the media files in the first ordering, wherein a first ad file is to be played after an end of a first media file and before a beginning of a second media file in the first ordering, and a second ad file

is to be played after an end of a third media file mad before an a beginning of a fourth media file in the first ordering (see [0026]-[0036]); after generating at the device the first sequencing of ad files, permitting the user to alter the first ordering to create a second ordering of the media files, wherein the user can alter the first ordering by navigating from within the first media file to another media file (see [0037]-[0039]).

Note: The claim recites providing a plurality of media file *available for download* and ***allowing a user to select*** a subset of the plurality of media files for download and storing the subset of media files in a memory of the device. Allowing the user to select does not mean the user takes an action to select. The user may or may not select the available media file. Since there is no step of user taking an action to select, there are no media files stored in the memory of the device. The claim also recites permitting the user to select a first ordering and permitting the user to alter the ordering. The "permitting' feature is there for the user to take action, but does not mean the action is taken by the user. The claim also recites third media file and fourth media file. Even if the user makes a selection of plurality of media files it does not mean there are a third and a fourth media file. The term plurality is interpreted to mean more than one. Therefore, if the user selected only two media files the step of playing a second ad file between the third and fourth media files does not happen.

It has been held that Language that suggest or makes optional but does not require steps to be performed or does not limit a claim to a particular structure does not limit the scope of a claim or claim limitation (MPEP §2106 II C).

However, if patentable weight was to be given to the optional steps, Knepper also teaches that when Associated Advertising Model (AAM) advertising model is used, a media file (show)

and its corresponding advertisement media files must be associated with one another. Further Knepper teaches while they exist as separate files … they must be played together by the client-side application … every time an AAM show is played it will have the same advertisement(s) within it for that particular association (see [0066]-[0070]. Therefore, whether a media file is played first or last the same ad file will be played after the media file, which indicates that the sequence of the ad file would also be altered.

Regarding claim 139, Knepper teaches wherein each media files stored in the memory does not include an embedded ad (see [0035]-[0041]).

Regarding claim 140, Knepper teaches wherein the user can alter the first ordering by navigating within the first media file (see fig. 6 and [0042]-[0044]).

Regarding claims 141, 142, 145, Knepper teaches claim 138 wherein the ad positioning rules are stored at the device; before the automatically generating the first sequencing of ad files, receiving the ad positioning rules at the device; wherein the second sequencing of ad files is automatically generated without receiving different ad positioning rules than used when generating the first sequencing of ad files; jumping out-of-sequence (see fig. 6, forward and reverse buttons) (see also [0034]-[0037], [0040-44], [0066]-[0070]).

Regarding claims 143 and 144 Knepper teaches at the device, playing the first ad file stored in the memory of the device as specified in the first sequencing of ad files, wherein the first ad file is played without streaming of the first ad file; at the device, playing the first media file stored in the memory of the device, wherein the first media file is played without streaming (see [0008]-[0014], [0041]-[0042]).

Regarding claims 147-149, Knepper teaches wherein the first sequencing of ad files specifies that no ad file is to be played immediately after the fourth media file, and after the user alters the first ordering to obtain the second ordering, the second sequencing of ad files specifies that a third ad file is to be played immediately after the fourth media file (see [0041], [0046], [0049], [0052]-[0057], [0085], [0086]).

Regarding claims 148-150, 164-166, Knepper teaches instruction set delivered to the client and used by the client is used to determine whether the download list contains instructions for including an advertisement and if not the non-advertisement media file is downloaded …; a single clip would have an advertisement at its beginning, at its end, both or not at all. (see [0083]-[0088]). Knepper also teaches that placement of advertisement media files within the show … a content provider can specify which clips may be preceded or followed by ads (see [0080]. Further Knepper teaches that the number of advertisement media files may be determined by the occurrence or level of a fee paid by the user (see [0084]).

Regarding claim 154, Knepper teaches ad files stored separately from the media files (see [0026]-[0030]).

Regarding claim 155-161, Knepper teaches wherein the permitting the user to alter the first ordering of playing of the media files comprises a set of operations comprising: the user advancing from playing of the first media file to the third media file before the reaching an end of the first media file, the user removing the second media file from the first ordering before the second media file is played by the media player, and the user adding a fifth media file to the first ordering, wherein when the user performs one of the set of operations, the second sequencing of ad files is automatically generated after that operation … (see fig. 6, 7, [0042]-[0048]).

Regarding claim 162, Knepper teaches for the first ordering, based on the ad positioning rules, automatically generating at the device a first sequencing of ad files to be played during playing of the media files in the first ordering; after generating at the device the first sequencing of ad files (see [0009]-[0014]); permitting the user to alter the first ordering of playing of the media files to create a second ordering of the media files stored in the memory for playing; and for the second ordering, based on the ad positioning rules, automatically generating at the device a second sequencing of ad files to be played during playing of the media files in the second ordering, wherein the second sequencing of ad files is different from the first sequencing of ad files, (see [0026]-[0036]); wherein the permitting the user to alter the first ordering of playing of the media files comprises a set of operations comprises the user advancing from playing of a first media file to a second media file in the first ordering before the reaching an end of the first media file, the user removing a third media file from the first ordering before the third media file is played by the media player, and the user adding a fourth media file to the first ordering, wherein when the user performs one of the set of operations, the second sequencing of ad files is automatically generated after the operation, and the second sequencing of ad files specifies that an ad file is played after an end of a media file in the second ordering and before a start of a next media file in the second ordering (see fig. 6, [0026]-[0039]).

Note: The claim recites providing a plurality of media file *available for download* and ***allowing a user to select*** a subset of the plurality of media files for download and storing the subset of media files in a memory of the device. Allowing the user to select does not mean the user takes an action to select. The user may or may not select the available media file. Since there is no step of user taking an action to select, there are no media files stored in the memory of

the device. The claim also recites permitting the user to select a first ordering and permitting the user to alter the ordering. The "permitting' feature is there for the user to take action, but does not mean the action is taken by the user. The claim also recites third media file and fourth media file. Even if the user makes a selection of plurality of media files it does not mean there are a third and a fourth media file. The term plurality is interpreted to mean more than one. Therefore, if the user selected only two media files the step of playing a second ad file between the third and fourth media files does not happen.

It has been held that Language that suggest or makes optional but does not require steps to be performed or does not limit a claim to a particular structure does not limit the scope of a claim or claim limitation (MPEP §2106 II C).

However, it patentable weight was to be given to the optional steps, Knepper also teaches that when Associated Advertising Model (AAM) advertising model is used, a media file (show) and its corresponding advertisement media files must be associated with one another. Further Knepper teaches while they exist as separate files … they must be played together by the client-side application … every time an AAM show is played it will have the same advertisement(s) within it for that particular association (see [0066]-[0070]. Therefore, whether a media file is played first or last the same ad file will be played after the media file, which indicates that the sequence of the ad file would also be altered.

Regarding claim 163, Knepper teaches navigating out-of-sequence from a first elapsed time with the first media file to a second elapsed time within the first media file (see fig. 6).

Regarding claim 167, Knepper teaches providing a plurality of media files available for download by an electronic device; allowing a user to select a first media file of the plurality of

media files for download; receiving the first media file at the electronic device; storing the first media file in a memory of the device; receiving a plurality of ad files to the electronic device for storage in the memory of the device (see [0009]-[0014]); at the device, based on ad positioning rules, automatically generating at the device a first sequencing of ad files to be played during playing of the first media file using a media player program; after generating at the device the first sequencing of ad files (see [0026]-[0039]), permitting the user to navigate playing within the first media file; and upon the user navigating within the first media file, automatically generating at the device a second sequencing of ad files to be played during a continued playing of the first media file, wherein the second sequencing of ad files is different from the first sequencing of ad files (see [0084])

Regarding claim 168, Knepper teaches wherein the first media file does not include any embedded ads (see [0035]-[0041]).

Regarding claim 170, Knepper teaches allowing the user to select a second media file of the plurality of media files for download; and receiving the second media file at the electronic device, wherein the automatically generating at the device a first sequencing of ad files comprises specifying that a third ad file be played after an end of the first media file and before a beginning of the second media file. Knepper teaches instruction set delivered to the client and used by the client to determine whether the download list contains instructions for including an advertisement, and if not the non-advertisement media file is downloaded …; a single clip would have an advertisement at its beginning, at its end, both or not at all. (see [0083]-[0088]). Knepper also teaches that placement of advertisement media files within the show … a content provider can specify which clips may be preceded or followed by ads (see [0080]. Further Knepper

teaches that the number of advertisement media files may be determined by the occurrence or level of a fee paid by the user (see [0084]).

Regarding claims 171 and 172, Knepper teaches wherein the user navigating the playing of the first media file comprises fast forwarding a playing of the first media file using the media player program, wherein the user navigating the playing of the first media file comprises changing to a next chapter in a playing of the first media file using the media player program (see fig. 6 and [0042]-[0044].

Regarding claims 175 and 176, Knepper teaches wherein the ad positioning rules specify playing an ad file at a fade-to-black point occurring in the first media file; wherein the ad positioning rules specify playing an ad file at markers located within the first media file Knepper teaches instruction set delivered to the client and used by the client is used to determine whether the download list contains instructions for including an advertisement and if not the non-advertisement media file is downloaded …; a single clip would have an advertisement at its beginning, at its end, both or not at all. (see [0083]-[0088]). Knepper also teaches that placement of advertisement media files within the show … a content provider can specify which clips may be preceded or followed by ads (see [0080]. Further Knepper teaches that the number of advertisement media files may be determined by the occurrence or level of a fee paid by the user (see [0084]).

Regarding claims 177, Knepper teaches before the automatically generating the first sequencing of ad files, receiving the ad positioning rules at the device, wherein the second sequencing of ad files is automatically generated without receiving different ad positioning rules

than used when generating the first sequencing of ad files (see [0034]-[0037], [0040-44], [0066]-[0070]).

Regarding claims 178-183, Knepper teaches wherein the ad positioning rules are stored at the device; before the automatically generating at the device the first sequencing of ad files, receiving in a memory of the device the ad positioning rules, wherein the first sequencing of ad files comprises only ad files wholly stored in the memory of the device; at the device, playing a first ad file stored in the memory of the device as specified in the first sequencing of ad files, wherein the first ad file is played without streaming of the first ad file; wherein the first media file is entirely received in the memory of the device before beginning playing of the first media file the media player program; wherein permitting the user to navigate playing within the first media file comprises paging forward or paging backward within the first media file; wherein the ad positioning rules specify an ad after a specified number of page turns (see fig. 6, forward and reverse buttons) (see also [0034]-[0037], [0040-44], [0066]-[0070]).

Regarding claims 184 and 185, Knepper teaches providing a plurality of media files available for download by an electronic device; allowing a user to select a subset of the plurality of media files for download; receiving the subset of media files at the electronic device; storing the subset of media files in a memory of the device; receiving a plurality of ad files at the electronic device for storage in the memory of the device; at the device, permitting a user to select a first ordering of the media files stored in the memory for playing by a media player program; and for the first ordering, based on ad positioning rules, using a processor of the device, automatically generating a first sequencing of ad files to be played during playing of the media files in the first ordering; after generating at the device the first sequencing of ad files,

permitting the user to alter the first ordering to create a second ordering of the media files, wherein the user can alter the first ordering by navigating using the media player from within the first media file to another media file, and wherein the user can alter the first ordering by navigating within the first media file (see fig. 6, [000]-[0014], [0026]-[0039]).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 151, 152, 169, 173 and 174 are rejected under 35 U.S.C. 103(a) as being unpatentable over Knepper further in view of official notice.

Regarding claims 151 and 152, Knepper teaches an ad positioning rules specifying an ad files playing between media files. Knepper also teaches the instruction set delivered to the client and used by the client is used to determine whether the download list contains instructions for including an advertisement and if not the non-advertisement media file is downloaded …; a single clip would have an advertisement at its beginning, at its end, both or not at all (see [0083]-[0088]). Knepper also teaches that placement of advertisement media files within the show … a content provider can specify which clips may be preceded or followed by ads (see [0080]. Further Knepper teaches that the number of advertisement media files may be determined by the occurrence or level of a fee paid by the user (see [0084]). Knepper does not explicitly teach presenting the ad file based on the amount of time the said media file content is presented to a user. However Examiner takes official notice that it is old and well known in the art of media

broadcasting to establish a time limit when a commercial should be played or presented. For example, advertisements are played every 60 minutes of presenting media programs. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to include in the instruction of Knepper rules specifying presentation of the ad every 60 minutes or so of playing the media file, in order to maximize the presentation of advertisement.

Claims 169, 173 and 174 are rejected as stated above in claim 151.

Claim 186 is rejected under 35 U.S.C. 103(a) as being unpatentable over Knepper further in view of Eyer et al. (US 6,588,015).

Regarding claim 186 Knepper teaches wherein in the first sequencing of ad files, a first ad file is to be played before a beginning of a first media file. However failed to specifically teach while the first ad file is being played by the media player, the user is not permitted to navigate using the media player, and after the first ad file has been player by the media player, and the first media file is being played, the user is permitted to navigate using the media player, it is taught in Eyer (see col. 6 lines 50-61, col. 16 lines 46-59, col. 18 lines 48-54). It would have been obvious to one of ordinary skill in the art at the time of the invention to add the control feature in Knepper as in Eyer for the intended purpose of making sure that the user or viewer listens or views the advertising message paid by the advertiser.

Response to Arguments

Applicant's arguments with respect to claims 138-186 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Yehdega Retta whose telephone number is (571) 272-6723. The examiner can normally be reached on 8-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric Stamber can be reached on (571) 272-6724. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR

system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

YR
/Yehdega Retta/
Primary Examiner, Art Unit 3622